PATENT

Atty Docket No.: 100111713-1
App. Ser. No.: 10/074,734

REMARKS

Favorable reconsideration of this application is respectfully requested in view of the amendments above and the following remarks.

Claims 1, 3, 5, 7, 18, and 23 have been amended and claim 26 has been added. Support for the amendments may be found on page 6, lines 22-27 and original claim 2. In addition, claims 2, 6, and 15-17 have been canceled without prejudice or disclaimer to the subject matter contained therein. Claims 1, 3-5, 7-14, and 18-26 are therefore pending, of which claims 1, 5, 18, 23, and 26 are independent.

No new matter has been introduced by way of the claim amendments or additions; entry thereof is therefore respectfully requested.

Claims 1-7, 12-14, and 23-25 were rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Green et al. (6,970,640) ("Green").

Claims 8 and 19 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Green in view of Eiref et al. (6,975,809) ("Eiref") and Nonomura et al. (6,907,188) ("Nonomura").

Claims 9-11 and 20-22 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Green in view of Nonomura.

Claims 15-18 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Green.

These rejections are respectfully traversed.

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Examiner Interview Conducted

The Applicants' representative would like to thank Examiner Chowdhury for the courtesies extended during the interview conducted on August 22, 2006. During the interview, Examiner Chowdhury explained how the Green reference was applied to the claims. Specifically, the Examiner explained that the video stream of Green was interpreted as a plurality of still images. Consequently, the Office Action appears to equate the claimed "still-picture file" to one of the plurality of frames in the video stream of Green.

Claim Rejections Under 35 U.S.C. §102(b)

The test for determining if a reference anticipates a claim, for purposes of a rejection under 35 U.S.C. § 102, is whether the reference discloses all the elements of the claimed combination, or the mechanical equivalents thereof functioning in substantially the same way to produce substantially the same results. As noted by the Court of Appeals for the Federal Circuit in *Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984), in evaluating the sufficiency of an anticipation rejection under 35 U.S.C. § 102, the Court stated:

> Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.

Therefore, if the cited reference does not disclose each and every element of the claimed invention, then the cited reference fails to anticipate the claimed invention and, thus, the claimed invention is distinguishable over the cited reference.

Claims 1-7, 12-14, and 23-25 were rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Green et al. (6,970,640) ("Green").

Independent claims 1, 5, and 23 have been amended to include the features of dependent claim 2 and to include, in claim 1, that the still-picture file includes only a single compressed digital photograph and does not include any digital video frames" and in claims 5 and 23, that "the still-picture file is one of a plurality of still-picture files and each still-picture file contains data representing only a single digital photograph and the still-picture file comprises one of a JPEG, GIF, and PNG file."

Green fails to teach each and every element of independent claim 1. More specifically, with respect to independent claim 1, Green fails to teach or suggest a "still-picture file," which "includes only a single compressed digital photograph and does not include any digital video frames." Green discloses only MPEG video sequences comprising a plurality of digital video frames. Therefore, Green fails to teach or suggest the features of claim 1 and claims 3-4, which depend therefrom.

With respect to independent claims 5 and 23, Green fails to teach or suggest at least "reading a still-picture file for a selected photograph from the DVD disc, wherein the still-picture file is one of a plurality of still-picture files and each still-picture file contains data representing only a single digital photograph and the still-picture file comprises one of a JPEG, GIF, and PNG file." Instead, Green is drawn only to the modification of video streams. Green discloses only the modification of MPEG files, and fails to teach or suggest still-picture files, which include a JPEG, GIF, or PNG file containing a single digital photograph. Therefore, Green fails to teach or suggest all of the features of independent claims 5 and 23.

Green also fails to teach or suggest "transcoding," which "includes extracting DCT data from the still-picture file and encoding and outputting a key picture frame using the DCT

data." The Office Action states that this feature is "an inherent characteristic" of Green. However, Green makes no mention of DCT data and the Office Action fails to provide a reason why DCT data would be inherent in Green. "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted)." (See MPEP 2163.07(a)).

There are many different methods of compressing images known in the art. Green makes no suggestion whatsoever to use DCT data to compress the video stream. Therefore, the Office Action does not meet the standard set forth in the MPEP to establish inherency because the Office Action merely suggests the possibility that Green could use DCT data.

Accordingly, Green fails to teach or suggest the features of independent claims 1, 5, and 23. Therefore, withdrawal of this rejection and allowance of claims 1, 5, and 23 and the claims that depend therefrom are respectfully requested.

Claim Rejections Under 35 U.S.C. §103(a)

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in MPEP § 706.02(j):

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference

> (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Therefore, if the above-identified criteria are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

Claim 18

Claim 18 was rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Green.

Independent claim 18 recites features similar to independent claims 1, 5, and 23. As discussed above, Green fails to teach or suggest each and every element of claims 1, 5, and 23. Therefore, Green fails to render claim 18 obvious and claim 18 is allowable over Green at least for the reasons set forth above.

Claims 8 and 19

Claims 8 and 19 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Green in view of Eiref and Nonomura.

Eiref and Nonomura fail to cure the deficiencies of Green discussed above. Accordingly, claims 8 and 19 are allowable at least by virtue of their respective dependencies on allowable claims 5 and 18.

Claims 9-11 and 20-22

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Claims 9-11 and 20-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Green in view of Nonomura.

Nonomura fails to cure the deficiencies of Green discussed above. Accordingly, the Office Action has failed to set forth a *prima facia* case of obviousness over claims 8-11 and 19-22 based upon the Green and Nonomura disclosures. As such, claims 9-11 and 20-22 are allowable at least by virtue of their respective dependencies on allowable claims 5 and 18. Therefore, withdrawal of these rejections and allowance of these claims is respectfully requested.

New Claim 26

Claim 26 has been added to further define the scope of the invention. Claim 26 is allowable over the cited documents of record for reasons similar to claims 5 and 23, as set forth above.

Conclusion

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below.

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Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

Dated: September 5, 2006 By

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